

REMARKS

This amendment responds to the Office action of October 19, 2005. Claims 1 through 41 are pending in the application. The Office action rejected all claims as obvious combinations of Stiehr (4931330), Emal (4042739), Wilson (5296277), and/or Slocum (5888614). Applicants believe their invention is patentable over the cited references and traverses the rejections. In addition to this amendment, Applicants provide herewith the declaration of Robert A. Denike, who has extensive experience in the field of the invention, which declaration provides evidence of objective indicia of nonobviousness of the invention (hereinafter Denike Decl.).

Stiehr discloses a slip-resistant surface coating 10 for applying to a bathtub surfaces. Col. 1, lines 10-13. Stiehr illustrates the fact that the problem of bubbling has been recognized for a long time in the industry, but never adequately dealt with and Stiehr makes no suggestion for solving the problem. Col. 4, lines 34-38. Stiehr blithely instructs that “all air bubbles” can be removed if the “sheet member is ... pressed in place.” *Id.* However, the inventors of the present application recognized that such ad hoc measures were inadequate—you can press all you want but the air merely compresses and the bubbles remain—and invented the claimed subject matter. *See* Application, page 1, line 14 – page 2, line 5, and, Denike Decl. ¶¶ 5.d and 5.e. That is one reason why the present claims are patentable.

Stiehr also points out that bathtub coatings become dirty and need to be scrubbed clean frequently. Col. 1, lines 44-50. Stiehr thus teaches away from the claimed invention, for reasons that will be explained more fully below.

Emal discloses a paper tape 16 for covering the seam 12 between two drywall panels 10, 11, which are forming a part of a wall. Col. 2, lines 27-45. The purpose of tape 16 in Emal is to provide a smooth surface for painting on and for blending with the panel surfaces with joint compound. Col. 1, lines 26-40. Emal does not disclose or suggest the use of the tape anywhere

but on a wall between the drywall panels, and does not disclose or suggest any motivation for applying a layer of grit material to tape 16. Emal does not disclose the use of tape 16 in any place where increased friction would be helpful, such as a floor or step. To the contrary, Emal teaches away from such a modification because the purpose of the tape is to provide a smooth surface that blends with the adjoining wall panels.

Furthermore, Stiehr teaches away from being modified to include the pinholes of Emal, because Stiehr, as noted above, teaches that its bathtub coating becomes frequently dirty and requires repeated scrubbing. Such holes in the coating of Stiehr would be undesirable as locations for bacterial growth and tearing and peeling of the tape under the repeated scrubbing. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant” In re *Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). In the present case, the prior art would lead one of ordinary skill in the art away from the claimed invention of a grip tape with pinholes or perforations for the reasons noted above.

The Office action does not point out any particular disclosure in Stiehr or Emal that would provide the motivation for the modification that Office action proposes. Such an unrequired and unsuggested modification would be particularly improper where, as here, Stiehr and Emal specifically teach away from the claimed invention. See, e.g., In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992). In Fritch, the Federal Circuit explains:

[T]he Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. ‘The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of

the references.’ ... Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teaching found in the prior art, the same inquiry must be carried out in the context of a purported obvious ‘modification’ of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification**. ... This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the invention.’

Id. at 1783-4 [emphasis added]. In this case, there is no motivation, incentive, suggestion or teaching in the cited references to make the modification required to produce the system recited in claim 1. Instead, the only motivation to make the proposed modification would be to reconstruct Applicants’ claimed invention in hindsight.

In fact, the law is “clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted). A suggestion, teaching or motivation to combine or modify references “must be clear and particular.” Id. (citation omitted). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’” of a suggestion, teaching or motivation to combine references. Id. (citation omitted). Furthermore, the Federal Circuit cautioned that combining prior art references without such a teaching, suggestion or motivation, “simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” Id. (citation omitted).

Applicants' invention is also patentable because of the existence of several *Graham v. John Deere* objective indicia of nonobviousness, as established by the attached Denike Declaration. Mr. Denike has 32 years of relevant experience in the field of the invention and is president of the maker and seller of the commercial embodiment of the invention, so he is well-qualified to assist the Office in understanding the objective indicia of the nonobviousness of the invention. Denike Decl. ¶ 3.

The objective indicia identified by Mr. Denike are: commercial success as a result of the claimed features of the invention, a long-felt need that was satisfied by the claimed features of the invention, and the subsequent appearance in the marketplace of competitors' tapes embodying the claimed features of the invention. Mr. Denike points out that Mob Grip has enjoyed great commercial success since NHS introduced it to the marketplace in 2004. Denike Decl. ¶ 5.a. After only two years of sales, Mob Grip tape has risen to be regarded as the second-best-selling grip tape for skateboards worldwide. *Id.* This, and the other indicia are the result of the Mob Grip tape's providing a grip tape with a plurality of perforations or pinholes. *Id.* ¶ 5.

Mr. Denike also points out the industry's failure for more than thirty years to meet a need for a grip tape that did not suffer from bubbling on installation. *Id.* ¶¶ 5.b., 5.d., and 5.e. The nonobviousness of the invention is further established by the fact that, after NHS introduced Mob Grip tape to the marketplace, at least two makers of grip tape began selling tapes that incorporated the features that are recited in the claims to the invention. *Id.* ¶ 5.c. Thus, Applicants have established that the claimed invention is patentable over the prior art for the reasons recognized in *Graham v. John Deere* and the other relevant case law.

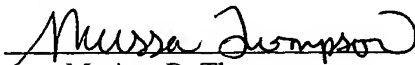
Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims.

If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.


Respectfully submitted,

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on March 17, 2006.


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